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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,097	04/10/2000	Henrick K. Gille	08041-007001	2573

20985 7590 11/21/2002

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EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/546,097

Applicant(s)

GILLE ET AL.

Examiner

Henry M Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 28-84 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 56-62 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 8-12, 29-32, 34-36, 39-44, 46-48, 51-55, 61-63, 66, 67, 69-74, 77, 78 and 80-84 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 7, 33, 37, 38, 45, 49, 50, 64, 65, 68, 75, 76 and 79 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 10, 11, 29, 32, 34, 40, 41, 42, 44, 46, 52, 53, 54, 63, 69, 71 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,228,800 to Degler et al. Degler et al discloses an electrosurgical instrument comprising an electrically insulated housing, constructed of a nonconductive material and having a substantially pencil shaped configuration, a blade assembly mounted in said housing and projecting from said housing, said blade assembly comprising a center electrode, insulation means on opposite sides of said electrode and side electrodes (Col. 7, lines 7-12). The center electrode has a beveled cutting edge and is stainless steel and the side electrodes are silver (Col. 7, line 39). The tip is essentially shaped like a lance (Figs. 3 and 5) and the electrodes are connected to the energy source (Fig. 2) via contacts (Fig. 3, #39) in the housing. A switch in the handle is provided to energize the electrode.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 9, 35, 36, 39, 47, 48, 51, 66, 67 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 4,640,279 to Beard. Degler et al is discussed above but does not teach the use of a non-stick

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coating. Beard discloses a surgical scalpel with an electrode attached to a non-cutting edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coating as taught by Beard in the invention of Degler et al to keep tissue from sticking to the device and reduce friction of the device in the tissue.

Claims 12, 43, 55 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,925,043 to Kumar et al. Degler et al is discussed above, yet does not teach the use of titanium nitride in the electrode. Kumar et al discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar et al in the electrode of Allen as an obvious design choice.

Claims 30, 31, 74, 80, 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi. Degler et al is discussed above, yet does not disclose the blade as being detachable. Haenggi teaches a multifunction electrocautery tool with a removable blade (Col 6, line 43). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the blade of Degler removable as taught by Haenggi to enable the blade to be replaced independently of the total assembly.

Claims 77, 78, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi as applied to claim 30 above, and further in view of U.S. Patent 4,640,279 to Beard. Beard discloses a surgical scalpel with an electrode attached to a non-cutting edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to use the coating as taught by Beard in the invention of Degler et al as modified by Haenggi to keep tissue from sticking to the device and reduce friction of the device in the tissue.

Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi as applied to claim 30 above, and further in view of U.S. Patent 5,925,043 to Kumar et al. Kumar et al discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar et al in the electrode of Degler et al as modified by Haenggi as an obvious design choice.

Response to Arguments

The Applicant's arguments filed 9/17/2002 have been fully considered. The rejections based on Degler et al are affirmed. Degler et al provides at least one electrode attached to a non-mechanical cutting edge of the tip. While the center electrode is on the cutting tip, the side electrodes (Fig. 7, #'s 37 and 38) are attached to the side of the device, not on the cutting tip. How Degler et al uses, or intends to use, this device is not relevant to the apparatus claims. The structure required is that at least one electrode is not attached to the cutting edge of the tip and Degler et al clearly anticipates that requirement by being attached to the side edge of the tip.

Allowable Subject Matter

Claim 28 is allowed.

Claims 3,4,7,33,37,38,45,49,50,56-62,64,65,68,75,76 and 79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Henry M. Johnson, III
Examiner
Art Unit 3739

Hmj
November 20, 2002


Lee Cohen
Primary Examiner